

REMARKS

The undersigned would like to thank the Examiner for the courtesies extended during the in-person Interview on September 8, 2004.

By this amendment, claims 1, 4, and 16 have been amended. The amendment has been made according to the Examiner's suggestions expressed during an in-person interview conducted September 8, 2004. Claims 1-21 and 23-26 are presently pending in this application. The Applicant respectfully requests reconsideration and allowance of the claims based upon the Remarks that follow.

In Section 6 of the Office Action, the Examiner rejected claims 1-19 and 21-25 under 35 U.S.C. §103(a) as being unpatentable over Arai (Unexamined Japanese Patent No. 8-249530) in view of Vazvan (WO 96/13814) and O'Mahony et al. "Electronic Payment Systems", and further in view of Martineau (U.S. Patent 5,915,226 A).

In the Office Action, although the Examiner conceded that "Arai does not teach using a removable identification module," the Examiner asserted that "transmitting customer identification via a contactless interface" reads on the "call originating source identification information" disclosed in Arai. The Applicant respectfully points out that the "transmission customer identification via a wireless interface . . . without an intermediate transceiver," as claimed in the amended claim 1, is between a removable identification module and a terminal. Unlike the invention as recited presently, in Arai, the "call originating source identification information" is not transmitted from an identification module to the terminal without an intermediate transceiver. Therefore, the Applicant respectfully submits that the Examiner's assertion is incorrect. The claimed "transmitting customer identification via a wireless interface . . . without an intermediate transceiver" is not described as suggested by Arai's "call originating source identification information."

The Examiner also asserted that “transmitting an electronic transaction amount reads on the value of the selected commodity,” but the Examiner did not refer to any part of the discussion in Arai to support this assertion. In Arai, the value of a selected commodity is passed on to a repeater from the vendor machine. In the claimed invention, the electronic transaction amount is transmitted from the identification module at the user end to the terminal via a wireless (contactless) interface. Based on the Examiner’s correct observation that Arai does not teach an “identification module,” Arai cannot teach “transmitting, from said identification module of said mobile radio telephone, an electronic transaction amount to said terminal via said wireless interface . . . without an intermediate transceiver,” as claimed in the amended claim 1. Therefore, the Applicant respectfully submits that “transmitting an electronic transaction amount from the identification module to the terminal” differs significantly from the disclosure in Arai of transmitting “the value of a selected commodity.”

The Examiner further asserted that “charging reads on the billing information stored at the terminal in the storage part, element 22,” as disclosed in paragraph 44 of Arai. The Applicant respectfully points out that “element 22” and the “storage part” are both part of the vendor machine, according to Arai. That is, even if “charging” might be said to correspond to “billing information,” the “billing information” in Arai is in the vendor machine (or terminal). This differs from the “charging” recited in claim 1, which occurs at the identification module of the mobile radio telephone of the user. Therefore, contrary to the Examiner’s assertion, the “charging” feature as claimed cannot read on Arai’s “billing information stored at the terminal in the storage part, element 22.”

The Examiner correctly pointed out that “Arai does not teach using a removable identification module.” To fashion the rejection, the Examiner posited that “Vazvan discloses a wireless telephone debit card removable from a radio telephone and that the card can be increased via wireless communication” and that it would have been obvious to modify Arai to

include the removable identification card taught by Vazvan. The Applicant respectfully disagrees. First of all, Arai does not suggest and provides no motivation to suggest such a combination. Secondly, even if combined, the combination does not perform the features claimed in the amended claim 1, and the combination does not render the claimed features obvious.

In Arai, charging occurs through a charging collection system. A mobile phone is used to identify a user who purchases a commodity. According to Arai, the mobile phone number serves as the customer identification. There is no motivation for Arai to include a removable card for the same purpose of identifying the user since this would be redundant. In addition, incorporating a removable card for the purpose of charging the user would render Arai's charging collection system purposeless. Therefore, Arai cannot be read to suggest such a combination. Without such a motivation or suggestion, the Examiner cannot establish a prima facie case of obviousness.

Furthermore, even if it could be said that there is a motivation for Arai to suggest such a combination, the combination of Arai and Vazvan will not achieve what is claimed. Vazvan teaches a real-time mobile tele-payment system to enable a mobile phone user to pay bills or transfer money from one account (e.g., the user's bank account) to another (e.g., to a utility company's bank account) (see page 3). Vazvan discloses an insertable SIM card that may include information related to the user's identity and/or the user's account information. A user can enter information related to a bill to be paid (e.g., payee's name, account associated with the payee, and amount to be paid, etc.). With a SIM card containing the user's identification information, there is no need for the user (payer) to enter information related to the payer's identity (see page 3, lines 7-32). Instead, a service provider (e.g., a wireless phone company and a bank) can directly identify the payer based on information stored on the SIM card.

In Vazvan, the bill payment is achieved by moving money from the payer's account (not through charging a monetary amount from the SIM card) to a specified payee's account (in a same or a different bank). That is, Vazvan does not teach a SIM card on which a monetary amount is stored, as claimed in claim 1. Consequently, it is not possible in the Vazvan device to directly charge the monetary amount stored in the SIM card, as claimed in claim 1. In addition, Vazvan does not teach that the monetary amount stored on a SIM card is electronically reloadable, as claimed in claim 1. Therefore, even if Arai's mobile phone were combinable with Vazvan's SIM card, the combination does not teach the features of charging a transaction amount from the monetary amount stored in an identification module and reloading the monetary amount stored in the identification module. Furthermore, as mentioned above, including in Arai's device a SIM card with a monetary amount stored thereon so that it can be charged directly would defeat the purpose of having a charging collection system. This is antithetical to the teachings in Arai.

The Examiner further asserted that "although the combination of Arai/Vazvan does not teach electronically signing the document, O'Mahony et al., pages 113-116, teach the particulars of a merchant capturing payment from a payment server," and the "electronically signing," as claimed in claim 1, reads on O'Mahony's teaching on electronically signing. Erroneously, this assertion is based on the assumption that other limitations recited in claim 1 are described or suggested what is taught in Arai/Vazvan combination. As clearly demonstrated above, this assumption does not hold. That is, the combination of Arai/Vazvan/O'Mahony does not remedy the above-presented deficiencies.

In the Office Action, the Examiner asserted that Martineau discloses "a combination SIM/smart card" where the smart card has "value units associated with the card," the SIM card is used "in a traditional subscription service," and "the stored value on the card may be replenished as necessary." Upon examining the disclosure of Martineau, the Applicant

respectfully points out that this assertion is incorrect.

Martineau teaches a mobile phone that facilitates services to both “credit worthy” and “credit challenged” groups of customers (see column 2, lines 42-44, column 3, lines 2-7). Martineau teaches the use of two cards in a single mobile phone (see Figure 1, numerals 8 and 10): a SIM card (numeral 10) and a smart card (numeral 8). The SIM card is preprogrammed to have two modes of operation: one is a restricted capability mode, e.g., only certain calls such as to customer services are allowed, and the other mode corresponds to a subscription mode where the SIM card is used as a subscription card after the user’s credit has been approved (column 3, lines 27-38). The usage of the SIM card can be switched between the two modes, depending on whether a credit check is successful (see column 3, lines 34-34).

The smart card is a second card or a prepaid card. The smart card is not needed when the SIM card is operating in the subscription mode. That is, the smart card is required only when the SIM card is operating in the restricted capability mode (see column 3, lines 38-43). This mode applies when the user is credit challenged. In this case, a prepaid card is necessary for the user to receive mobile phone service. In this restricted mode, the SIM card operates in conjunction with the prepaid card: information is exchanged between the two cards (column 6) and the remaining units in the prepaid card are updated (deducted) continuously during a service period (see column 7). When the prepaid card is used up, a new prepaid card needs to be purchased to replace the old one (see column 3, lines 46-48). Therefore, Martineau teaches how to utilize two cards (SIM/smart card) in different operating modes to provide services to different groups of customers (credit worthy and credit challenged).

In the present invention, claim 1 recites that “identification module is removable and stores at least the customer identification and a monetary amount” and “said monetary amount is able to be reloaded through secured reloading documents ... wherein said reloading

documents are transmitted by means of digital messages ...”. Martineau does not teach or suggest a single removable card (identification module) which stores both a customer identification and a monetary amount, as claimed in claim 1. Martineau does not teach or suggest that the “monetary amount is able to be reloaded through secured reloading documents ... wherein said reloading documents are transmitted by means of digital messages ...”. In Martineau’s device, the SIM card remains unchanged and a new smart card have to be purchased when the units on a previous smart card are used up. Therefore, Martineau, even if combined with Arai/Vazvan/O’Mahony, cannot remedy the deficiencies mentioned above. In addition, as discussed earlier, Arai contains no motivation to suggest such a combination (to charge directly on the smart card), because such a combination would defeat the purpose of having a charging collection system, as taught in Arai.

For the above stated reasons, the Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness with respect to claim 1. Therefore, the Applicant respectfully request that the rejection of claim 1 under 35 U.S.C. §103(a) be withdrawn.

Claims 2-19 and 21-25 depend from claim 1. Consequently, claims 2-19 and 21-25 are patentable at least for the reasons stated above with respect to claim 1 and for the additional features recited therein. Therefore, the Applicant respectfully requests that the rejection of claims 2-19 and 21-25 under 35 U.S.C. §103(a) be withdrawn.

In Section 7 of the Office Action, the Examiner rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over Arai/Vazvan/O’Mahony/Martineau and further in view of Yacobi.

As pointed out above, the Examiner has failed to establish a prima facie case of obviousness with respect to claim 1 based on the combination of Arai/Vazvan/O’Mahony/Martineau. The Applicant respectfully submits that the reliance on

Yacobi does not remedy the deficiencies discussed above. Yacobi describes a combined usage of symmetrical and asymmetrical encryption for transmission of monetary information wherein the session key (symmetrical) is encrypted with the recipient's public key (asymmetrical). Yacobi does not disclose, teach, or fairly suggest a transaction method in which an insertable SIM card is used that can be directly charged and electronically reloaded, as recited in claim 1. Therefore, Arai/Vazvan/O'Mahony/Martineau and further in view of Yacobi fails to disclose, teach, or suggest at least the features discussed above, as claimed in claim 1.

More importantly, claim 20 depends from claim 1. Consequently, claim 20 is patentable at least for the reasons stated above with respect to claim 1 and for the additional features recited therein. Therefore, the Applicant respectfully requests that the rejection of claim 20 under 35 U.S.C. §103(a) be withdrawn.

In Section 8 of the Office Action, the Examiner rejected claims 26 under 35 U.S.C. §103(a) as being unpatentable over Arai/Vazvan/O'Mahony/Martineau and further in view of Pitroda. As pointed out above, the Examiner has failed to establish a prima facie case of obviousness with respect to claim 1 based on the combination of Arai/Vazvan/O'Mahony/Martineau. Moreover, the Applicant respectfully submits that the reliance on Pitroda does not remedy the deficiencies discussed above.

Pitroda describes a transaction method wherein a communication interface unit (CIU) (terminal), upon receiving client information (such as name and account number) from a universal electronic transaction card (UET) (identification element) (see column 16, lines 37-41), contacts a server (e.g., a financial institution such as American Express service) and transmits transaction-specific information, CIU identification information, and the received client information, to the server (column 16, lines 42-47). When the server receives the information, the server performs credit check and sends an authorization number to the CIU

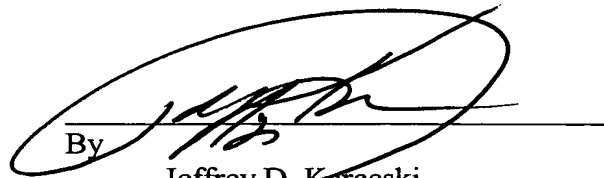
(column 16, lines 50-52). When the CIU receives the authorization number from the server, the CIU requests the client to authorize the transaction (column 16, lines 54-56). Pitroda does not teach an insertable SIM card that can be directly charged and electronically reloaded, as recited in claim 1. Therefore, Arai/Vazvan/O'Mahony/Martineau and further in view of Pitroda fail to disclose, teach, or suggest at least the features discussed above, as claimed in claim 1.

More importantly, claim 26 depends from claim 1. Consequently, claim 26 is patentable at least for the reasons stated above with respect to claim 1 and for the additional features recited therein. Therefore, the Applicant respectfully requests that the rejection of claim 26 under 35 U.S.C. §103(a) be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and a notice to that effect is earnestly solicited. Should the Examiner have any questions, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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